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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,096	10/05/2004	Kia Silverbrook	YUI85NPUS	5054
24011 7590 04/10/2009 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER				
SOLOMON, LISA				
ART UNIT		PAPER NUMBER		
2861				
MAIL DATE		DELIVERY MODE		
04/10/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/510,096

Applicant(s)

SILVERBROOK ET AL.

Examiner

LISA M. SOLOMON

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverbrook (6,213,589).

Silverbrook (589') teaches a thermoelastic actuator assembly (See Fig. 1), including:

In re claim 1: a heating element (27, 29, Fig. 1) including a heating layer (29) bonded to a passive bend layer (24, 25, Fig. 1), the passive bend layer (24, 25) being comprised of non-heat conductive material [Column 6 lines 23-31; 35-39; 49-56]; a heat conduction means (27) positioned within said passive bend layer (24, 25) so as to be spaced from the heating layer (29) to conduct heat generated by the heating element away from said actuator assembly thereby facilitating the return of the actuator to a quiescent state subsequent to operation [Column 6 lines 23-31; 57-64, See also Fig. 1].

In re claim 2: wherein the heat conduction (27) means comprises one or more layers of a metallic heat conductive material located within the passive bend layer (24, 25) [Column 6 lines 23-28, See also Figs. 1 and 2].

In re claim 3: wherein the one or more layers (27) of metallic heat conductive material is sufficient to prevent overheating of ink in contact [not given patentable weight] with said actuator (see Fig. 1) [Column 6 lines 23-28; 57-64].

Note: The following claim language "sufficient to prevent overheating of ink in contact" has been construed as functional language. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch&Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Therefore, the claim language "sufficient to prevent overheating of ink in contact" has not been given patentable weight. In addition, because the prior art reads on the structure as claimed, it is thus inherent that the layer (27) of a metallic heat conductive material with the passive bend layer (24, 25) would be sufficient to prevent overheating of ink in contact with the actuator.

In re claim 4: wherein the one or more layers (27) of metallic heat conductive material comprise a laminate of heat conductive material and passive bend layer substrate (24, 25) [See Fig. 1].

In re claim 5: wherein the one or more layers (27) of metallic heat conductive material comprise Aluminum [Column 6 lines 26-28].

In re claim 6: An ink jet printer including a thermoelastic actuator (see Fig. 1) according to claim 2 [Column 5 lines 59-63, Column 6 lines 23-31].

Response to Arguments

3. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LISA M. SOLOMON whose telephone number is (571)272-1701. The examiner can normally be reached on Monday - Friday from 8:00 am - 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Luu can be reached on (571) 272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MATTHEW LUU/
Supervisory Patent Examiner, Art Unit 2861

Lisa M Solomon
Examiner
Art Unit 2861